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EXAMINER				
ZARKA, DAVID PETER				
ART UNIT		PAPER NUMBER		
2624				
NOTIFICATION DATE		DELIVERY MODE		
01/25/2012		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/596,321

**Applicant(s)**

CARLSEN ET AL.

**Examiner**

DAVID ZARKA

**Art Unit**

2624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 December 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-10 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-10 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-501)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

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### **Amendments & Claim Status**

[1] This Detailed Action is responsive to Appeal Brief Under 37 C.F.R. § 41.37 ("Appeal Brief") received Oct. 24, 2011. Claims 1-10 remain pending.

In response to Appeal Brief, the previous rejected Claims 1 and 8-10 under 35 U.S.C. § 102(b) as being anticipated by Pardas et al., U.S. Pub. No. 2003/0048955 ("Pardas"); and rejected Claim 7 under § 103(a) as being unpatentable over Pardas in view of Moshfeghi, U.S. Pat. No. 5,633,951 ("Moshfeghi"),  
are withdrawn.

[2] Appeal Brief at 7-10 regarding rejected (i) Claims 1 and 8-10 under 35 U.S.C. § 102(b) as being as being anticipated by Pardas; and (ii) rejected Claim 7 under § 103(a) as being unpatentable over Pardas in view of Moshfeghi have been considered, but are now moot.

[3] In view of Appeal Brief, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624

### **Claim Rejections - 35 U.S.C. § 112**

[4] The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

#### New Matter

Applicant respectfully disagree and direct Examiner's assertion that the specification only provides support only for selecting at least one further landmark in the second image, but not the first. Applicant then provides direct specification support for figs. 3-6 being either a floating image A or reference image B. Figs. 3-6 are in fact a progression of "**one and the same** image (either the first image or the second image)." Appeal Brief at 6 (emphasis in original). "One of ordinary skill in the art would understand that this process is necessary in order to determine a similarity between the first and the second images." Id.

However, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." M.P.E.P § 2111 titled "CLAIM INTERPRETATION: BROADEST REASONABLE INTERPRETATION".

Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

...

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

M.P.E.P. § 2111.

Examiner agrees it is incorrect to state the specification only provides support only for selecting at least one further landmark in the second image, but not the first. Examiner agrees with Applicant's interpretation, after Applicant pointing to specific areas of the specification), that figs. 3-6 are one and the same image.

However, a broadest reasonable interpretation also supports figs. 3-6 are the same image when the claims use "first image" and "second image" language. See Specification at p. 5, ll. 30-31 (citing "Figs. 3 to 6 show simplified sketches of image").

Since the claim language supports both Applicant's and Examiner's interpretation, the claims are rejected under 35 U.S.C. § 112, first and second paragraph for the reasons provided below.

Applicant argues the Examiner asserting Applicant's reference to the above-cited portions of the Specification do not relate to figs. 3-6.

However, Examiner agrees with Applicant's interpretation, after Applicant pointing to specific areas of the specification), that figs. 3-6 are one and the same image.

Applicant argues that because there is no physical change to the image in any of figs. 3-6 (i.e., the selection of landmarks does not represent a physical change to the image), figs. 3-6 represent only a single image.

However, the features upon which applicant relies (i.e., that images must incorporate physical changes and/or landmark selection to be separate images) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues two of the same identical image side-by-side are not separate images, even if the same identical images are separately saved in memory. The

claim language cites "first image" and "second image" only. Applicant's specification broadly refers to figs. 3-6 as "images" (plural). Examiner believes, if "first image" and "second image" broad language is used, that figs. 3-6 are separate images for just occupying different areas of the drawing page.

It is suggested to change to "~~first~~ floating image" and "~~second~~ reference image". Applicant's specification explicitly provides support, provided by Applicant, that figs. 3-6 are either a floating or reference image.

[5] **Claims 1-10** are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

"an image processing device" claim language

Claim 1, lines 3, 5, and 8 introduce separate "an image processing device". The claim language supports both the same and different image processing devices. However, it appears the specification only supports the same image processing device. The specification does not provide support for different image processing devices, and thus new matter. Claim 2 by analogy.

"the first image" and "the second image" claim language

Examiner's claim interpretation includes wherein "the first image" and "the second image" (introduced in Claims 1, 2, 8 and 9) are both included in figs. 3-6 (figs. 3-6 being separate images). See M.P.E.P § 2111 titled "CLAIM INTERPRETATION: BROADEST REASONABLE INTERPRETATION". However, as argued by Applicant, figs. 3-6 are in fact the same image and the specification does not provide support for figs. 3-6 being separate images. See Appeal Brief at 5-7. Applicant argues the Specification only provides enablement for figs. 3-6 being separate images. It follows the claims thus introduce new matter using "first image" and "second image" language.

It is suggested to change to "~~first~~ floating image" and "~~second~~ reference image".

[6] The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[7] **Claims 1-10** are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“an image processing device” claim language

Claim 1, lines 3, 5, and 8 introduce separate “an image processing device”. It is unclear whether the image processing devices are (i) the same image processing device; or different image processing devices. If different, it is suggested to change to “a first image processing device”, “a second processing device”, and “a third processing device”. If the same, it is suggested to change to “an image processing device”, “said image processing device”, and “said image processing device”.

Claim 2 by analogy.

“the first image” and “the second image” claim language

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see M.P.E.P. § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984)

M.P.E.P. § 2143.02.

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph for being subject to more than one interpretation.

The first interpretation is that of the Examiner (rendering the claim unpatentable over the prior art), wherein

(i) “the first image” and “the second image” are both included in figs. 3-6 (figs. 3-6 being separate images); and

(ii) if figs. 3-6 are separate images, only "at least one further second landmark is the second image" is selected for registration, and not "at least one further first landmark" is selected for registration. See M.P.E.P § 2111 titled "CLAIM INTERPRETATION: BROADEST REASONABLE INTERPRETATION".

However, Applicant's interpretation includes wherein

- (i) "the first image" and "the second image" are both not included in figs. 3-6 (figs. 3-6 being the same image); and
- (ii) if figs. 3-6 are the same image, both "at least one further first landmark" and "at least one further second landmark is the second image" are selected for registration.

It is suggested to change to "first floating image" and "second reference image".

### **Allowable Subject Matter**

[8] **Claims 1-10** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, first and second paragraphs.

#### Reasons for Indicating Allowable Subject Matter

[9] The following is a statement of reasons for the indication of allowable subject matter:

Regarding **Claim 1**, the prior art of record does not teach selecting at least one further first landmark in the first image and at least one further second landmark in the second image if the similarity value is less than a pre-selected value. **Claims 8 and 9** would be allowable by analogy.

Regarding **Claim 2**, the prior art of record does not teach wherein the second number is the first number plus one; wherein the first and second landmarks are selected in accordance with a qualifying function, and wherein the third number is equal to the second number.

### **Conclusion**

[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID ZARKA whose telephone number is (571)270-1578 and fax number (571)270-2578. The examiner can normally be reached Monday - Friday 7:30 - 17:00 ET.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-74537453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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